



14 FEB 2000

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In re Application of DUBOIS	:	
Application No.: 09/194,996	:	
PCT No.: PCT/FR97/01024	:	DECISION ON
International Filing Date: 10 June 1997	:	
Priority Date: 11 June 1996	:	PETITION UNDER
For: TRANSDERMIC SYSTEMS CONTAINING	:	
2 ACTIVE INGREDIENTS IN SEPARATE	:	37 CFR 1.47(b)
COMPARTMENTS, THEIR PREPARATION	:	
PROCESS AND USE AS MEDICAMENTS	:	

This decision is in response the PETITION UNDER 37 C.F.R. §1.47(b) filed 20 September 1999.

BACKGROUND

On 10 June 1997, applicants filed international application, PCT/FR97/01024, claiming priority of French application 96/07209, filed 11 June 1996. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 18 December, 1997. A Demand for international preliminary examination, in which the United States was elected, was filed 31 December 1997. Accordingly, the thirty month time period for paying the basic national fee in the United States in accordance with 37 C.F.R. 1.495(b), expired midnight on 11 December 1998.

On 4 December 1998, applicants filed a Transmittal Letter requesting entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee and an unexecuted Declaration.

On 20 April 1999, the United States Patent and Trademark Office (PTO) mailed applicants a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371", (PCT/DO/EO/905) and a "NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION" (PCT/DO/EO/917) which indicated that the Declaration was not properly executed, and set a one month time period for response.

On 20 September 1999 applicants submitted a "COMPLETION OF APPLICATION". This submission included the requisite surcharge for filing the declaration later than 30 months from the priority date; a Petition and fee for a four month extension of time; a Petition under 37 CFR 1.47(b) and requisite fee; a Declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors; Supporting Declaration Under Rule 47 by Jean-Claude Vieillefosse; and other supporting documentation.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after a diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Applicants have satisfied items (1) and (6) above.

In regard to item (5) above, applicant attempts to demonstrate sufficient proprietary interest in the application by showing that the inventor, DUBOIS, had agreed in writing to assign the invention. The following proofs are provided in support of such contention:

1. Employment contract of DUBOIS (with english translation);
2. Attestation of DUBOIS employment (with english translation);
3. Declaration for Designation of Inventors (with no english translation);
4. French Law No. 92-597, Section II, Right to Title (with english translation).

MPEP 409.03(f) states in part:

A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Lacking such an affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant, sufficient proprietary interest in the application has not been demonstrated. Further, note that an english translation of the Declaration for Designation of Inventors should be provided if such document is to be relied upon. Further still, if the French Law Section is to be relied upon for showing proprietary interest, instead of the employment contract, a legal memorandum as described in the last paragraph of MPEP 409.03(f) would be required.

In regard to item (4) above, the declaration must be made by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor. However, it is not clear from the record that Jean-Claude Vieillefosse, whose title is "Head of the Patent Department", has authority to sign the Declaration on behalf of the 37 CFR 1.47(b) applicant, Hoechst Marion Roussel. Further, 37 CFR 1.63 requires both the inventor's place of residence and post office address to be included in the declaration.

MPEP 605.03 states in part:

In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.

The declaration does not include DUBOIS's current place of residence or home address. It purports to list merely a former place of residence and address of DUBOIS (17 rue Anatole France, 91120 Palaiseau, France), and the address of his current employer, Sanofi Recherche (371 rue du Professeur Blayac, 34000 Montpellier, France).

In regard to item (3) above, it is not clear from the submission which stated address is the last known address of the inventor. As stated above, the declaration lists a former place of residence and address of DUBOIS (17 rue Anatole France, 91120 Palaiseau, France), and the address of his current employer, Sanofi Recherche (371 rue du Professeur Blayac, 34000 Montpellier, France). These two addresses also appear throughout the other submitted documentation and correspondences. A further address (63 rue de Meaux, 75019 Paris, France) is listed as the residence of DUBOIS on the Attestation of employment prepared by Jocelyne Saulquin on 28 April 1999, and was the address used in the correspondence from Manuela Louvet to DUBOIS dated 9 November 1998. Clarification as to the last known address of DUBOIS is required.

In regard to item (2) above, applicant contends that DUBOIS refuses to execute the application. The following three correspondences, along with english translations thereof, are provided, and discussed on page two of the Supporting Declaration Under Rule 47 by Jean-Claude Vieillefosse:

1. Letter from Manuela Louvet to DUBOIS dated 9 November 1998 requesting his address.
2. Telefax from Jean-Claude Vieillefosse to DUBOIS dated 2 December 1998 requesting his address.
3. Letter from Jean-Claude Vieillefosse to DUBOIS dated 30 December 1998 which included the application, declaration, and assignment for execution.

Further, at least one "recent telephone conversation" between Jean-Claude Vieillefosse and DUBOIS is referenced on the first line of the 30 December 1998 letter, and "repeated telephone calls" by Jean-Claude Vieillefosse and DUBOIS are referenced on page 3 of the Supporting Declaration Under Rule 47 by Jean-Claude Vieillefosse. However, no details or documentation of such telephone communications are provided.

MPEP 409.03(d) states in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Adequate factual proof that DUBOIS refuses to execute the application has not been provided. The three correspondences described above merely demonstrate that two attempts were made to contact DUBOIS regarding his address, and that in the third correspondence he was provided with the application, declaration, and assignment for execution. Apparently sometime between the second and third correspondences (2 December 1998 to 30 December 1998), at least one telephone conversation between Vieillefosse and DUBOIS occurred, as referenced on the first line of the 30 December 1998 correspondence. However, as stated above, no details or documentation of such telephone conversation have been provided, including whether DUBOIS indicated that he would execute such documents.

On page 3 of the Supporting Declaration Under Rule 47 by Jean-Claude Vieillefosse he concludes that since the executed documents were never returned by Mr. Dubois, this indicates refusal on his part. However, no details of any of the telephone calls between Jean-Claude Vieillefosse and DUBOIS have been provided. Lacking any further explanation or documentation, particularly in regard to the referenced telephone communications, refusal on the part of DUBOIS will not be presumed, and has not been adequately demonstrated.

CONCLUSION

For the reasons discussed above, the petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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